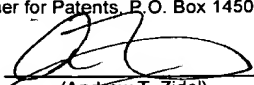


I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to:
Appeal Brief - Patents, Commissioner for Patents, P.O. Box 1450,
Alexandria, VA 22313-1450.

Dated: August 2, 2006

Signature:


(Andrew T. Zidel)

Docket No.: SONYJP 3.3-1245
DIV I
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Patent Application of:
Fumitake Yodo

Application No.: 09/923,702

Group Art Unit: 3627

Filed: August 7, 2001

Examiner: A. J. Fischer

For: TERMINAL DEVICE, ACCOUNTING
SYSTEM, AND DATA PROCESSING
METHOD

**RESPONSE TO NOTIFICATION OF NON-COMPLIANT
APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37**

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

This is in response to the Notification of Non-Compliant Appeal Brief mailed June 2, 2006 concerning the Appeal Brief filed February 22, 2005. The Appeal Brief filed February 22, 2005 has been amended to comply with the Order of the Board of Patent Appeals and Interferences of May 3, 2006 and the Notification of Non-Compliant Appeal Brief pursuant to 37 C.F.R. § 41.37.

A Corrected Appeal Brief is being submitted herewith for consideration.

Application No.: 09/923,702

Docket No.: SONYJP 3.3-1245 DIV I

No fee is believed due in this matter. However, in the event that any fee is due in connection with the foregoing, the Commissioner is hereby authorized to charge the same to our Deposit Account No. 12-1095.

Dated: August 2, 2006

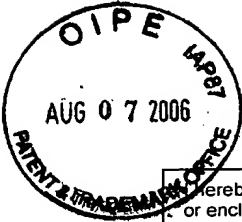
Respectfully submitted,

By 

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Dated: August 2, 2006

Signature: 

(Andrew T. Zidel)

Docket No.: SONYJP 3.3-1245
DIV I
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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In re Patent Application of:
Fumitake Yodo

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For: TERMINAL DEVICE, ACCOUNTING
SYSTEM, AND DATA PROCESSING
METHOD

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: Examiner: A. J. Fischer
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CORRECTED APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.37(D)

MS Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby files this corrected appeal brief in response to the Notice of Non-Compliant Appeal Brief issued on June 2, 2006. The corrected appeal brief appeals from the final rejection of claim 9 mailed October 12, 2004, and in response to the Advisory Action mailed December 6, 2004. The Commissioner was previously paid the fee required by 37 C.F.R. § 41.20(b)(2) for filing the brief. If any other fees are due and owing in connection with the brief, please charged it to Deposit Account No. 12-1095. A one-month extension of time is submitted herewith.

The original appeal brief in the instant application was filed on February 22, 2005, and an Examiner's Answer was mailed

on May 19, 2005. The Board of Patent Appeals and Interferences issued an Order returning the undocketed original appeal brief to the Examiner on May 3, 2006, stating that the application was not ready for appeal because the original appeal brief was filed pursuant to 37 C.F.R. § 1.192(c), which was abolished on September 13, 2004, and replaced by 37 C.F.R. § 41.37(c).

The Examiner issued a Notification of Non-Compliant Appeal Brief that was mailed on June 2, 2006. This corrected appeal brief is submitted to correct the defects of the original appeal brief. Applicant submits that this corrected appeal brief is now compliant with 37 C.F.R. § 41.37(c) and requests docketing of the application for appeal.

REAL PARTY IN INTEREST

This application is assigned to Sony Corporation, 7-35 Kitashinagawa 6-chome, Shinagawa-ku, Tokyo, Japan by the Assignment recorded July 17, 2000, at Reel 010981, Frame 0857.

RELATED APPEALS AND INTERFERENCES

The instant application is a divisional of U.S. Patent Application No. 09/600,509 ("Parent Application"), filed July 17, 2000. An Appeal Brief in the Parent Application was filed on January 17, 2006, an Examiner's Answer was filed on April 19, 2006, and a Reply Brief was filed on June 16, 2006, along with a request for an oral hearing. As of the date of this corrected appeal brief, an appeal number has not been assigned in the Parent Application.

Another divisional application of the Parent Application; namely, U.S. Patent Application No. 09/923,618 ("Sibling Application") was filed on August 7, 2001. An Appeal Brief in the Sibling Application was filed on November 22, 2004, and an Examiner's Answer was filed on February 17, 2005. A request for an oral hearing was filed on March 3, 2005. As of

the date of this corrected appeal brief, an appeal number has not been assigned in the Sibling Application.

As indicated in the accompanying Related Proceedings Appendix, the Board of Patent Appeals and Interferences has not issued any decisions in the appeals of the Parent and Sibling Applications.

STATUS OF CLAIMS

This application, which is a division of Application Serial No. 09/600,509 filed July 17, 2000, was originally filed with 12 claims and a Preliminary Amendment canceling claims 1-7 and 10-12. Claims 8 and 9 were amended by the Amendment mailed July 18, 2002, and by the Amendment mailed December 19, 2002. Claim 8 was cancelled and claim 9 was amended by the Amendment mailed July 31, 2003. Claim 9 was amended by the Amendment mailed December 15, 2003, and by the Amendment mailed June 25, 2004. A Response, without any claim amendments, was mailed November 22, 2004, and an Advisory Action maintaining the final rejection of October 12, 2004, was mailed December 6, 2004. Claim 9, the sole claim pending in this application, stands finally rejected and is the basis of this Appeal. As indicated in the Evidence Appendix attached hereto, no evidence is being submitted in this Appeal pursuant to 37 C.F.R. § 1.130, § 1.131, or § 1.132.

STATUS OF AMENDMENTS

In response to the final rejection mailed October 12, 2004, a Response, without any claim amendments, was mailed November 22, 2004. An Advisory Action was mailed on December 6, 2004. The Advisory Action considered the Response but maintained the final rejection of October 12, 2004. Claim 9, the sole claim pending in this application, stands finally

rejected and is set forth in the Claims Appendix attached hereto.

SUMMARY OF CLAIMED SUBJECT MATTER

The presently claimed invention relates to an accounting system (p.5 11.12-17; Fig. 1) including an accounting center (p.6 1.21 to p.8 1.12; 1 in Fig. 1) and a terminal device (p.6 1.5 to p.7 1.13; 10 in Fig. 1) communicating with the accounting center (as shown in Fig. 1). Exemplary references are made to specific pages and lines in the specification, and to certain elements in the figures.

The terminal device (10 in Fig. 1) comprises:

a first memory (p.15 11.16-21; 45 in Fig. 3) configured to store accounting points, the first memory being built-in in the terminal device (10 in Fig. 1);

a second memory (p.16 11.12-16; 15 in Fig. 3) configured to store distributed information from an external source (1 in Fig. 1);

a first controller (p.15 11.19-21; p.31 11.8-11; 11 in Fig. 3) configured to update the accounting points (p.15 11.16-19; p.50 1.13 to p.51 1.1; S66 in Fig. 13) stored in the first memory (45 in Fig. 3) and to update attributes (e.g., a permission flag; p.28 1.16 to p.29 1.2) of the distributed information when the distributed information is stored in the second memory (p.50 1.19 to p.51 1.1; 15 in Fig. 3; S67 in Fig. 13);

a second controller (p.53 11.1-5; 11 in Fig. 3) configured to transmit a request for purchasing the accounting points to the accounting center (p.53 11.1-5; S73 in Fig. 13) and to update the accounting points (p.54 11.2-13; S76 in Fig. 13) stored in the first memory (45 in Fig. 3) based on an accounting processing (p.53 11.3-5; S74 in Fig. 13) corresponding to the

accounting points executed at the accounting center (1 in Fig. 1); and

a detector (p.9 1.16 to p.10 1.5; MT in Fig. 1) configured to detect whether a portable device with a storage medium (p.8 1.13 to p.9 1.1; 50 in Fig. 1) is connected to the terminal device (p.56 11.16-18; S81 in Fig. 14), wherein

when the distributed information is stored in the second memory (p.50 11.4-7; p.56 11.2-9; 15 in Fig. 3; S63 in Fig. 13), the first controller (11 in Fig. 3) updates the attributes of the distributed information to an unavailable state (p.50 11.7-9; S64 in Fig. 13) and updates the accounting points stored in the first memory (p.15 11.19-21; 45 in Fig. 3) based on the distributed information, and when the accounting points are not updated correctly, the second controller (11 in Fig. 3) transmits the request for purchasing the accounting points (pg.53 11.1-5; S73 in Fig. 13) to the accounting center (1 in Fig. 1) and updates the accounting points (p.54 11.2-13; S76 in Fig. 13), and the first controller (11 in Fig. 3) updates the attributes of the distributed information from the unavailable state to an available state (p.50 1.19 to p.51 1.1; S67 in Fig. 13), and

when the detector (p.9 1.16 to p.10 1.5; MT in Fig. 1) detects that the portable device (p.8 1.13 to p.9 1.1; 50 in Fig. 1) is connected to the terminal device (p.56 11.16-18; 10 in Fig. 1; S81 in Fig. 14), the first controller (11 in Fig. 3) updates attributes of information stored in the storage medium (p.56 11.16-20; S82-83 in Fig. 14) of the portable device (50 in Fig. 1) from an unavailable state to an available state (p.57 11.7-12; S86 in Fig. 14) after the accounting points are updated correctly (p.57 11.3-6; S84-85 in Fig. 14).

The accounting center (1 in Fig. 1) comprises:

a third controller (p.6 1.21 to p.8 1.12; 1 in Fig. 1) configured to carry out an other accounting processing based on the request for purchasing the accounting points (p.53 11.8-12; S96 in Fig. 15) transmitted from the terminal device (10 in Fig. 1) by the second controller (11 in Fig. 3).

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(A) Whether claim 9 is patentable under 35 U.S.C. § 103(a) over U.S. Patent No. 5,857,020 ("*Peterson '020*").

(B) Whether claim 9 is patentable under 35 U.S.C. § 103(a) over *Peterson '020* in view of "*How Computers Work*," by Ron White, copyright 1999 ("*How Computers Work*").

ARGUMENT

As described above in the "SUMMARY OF CLAIMED SUBJECT MATTER" section of this brief, features of the claimed accounting system include an accounting center and a terminal device communicating with the accounting center. The terminal device has first and second memories and first and second controllers, as well as a detector configured to detect whether a portable device with a storage medium is connected to the terminal device.

The claimed invention handles different conditions in specific manners. For instance, when distributed information is stored in the second memory, the first controller updates attributes of the distributed information to an unavailable state and also updates accounting points stored in the first memory based on the distributed information.

When the accounting points are not correctly updated, the second controller transmits a request to purchase accounting points to the accounting center. The first controller updates the attributes of the distributed information from the unavailable state to the available state. In the accounting

center, the third controller is configured to carry out accounting processing based on the purchasing request.

When the detector detects that the portable device is connected to the terminal device, the first controller updates attributes of information stored in the storage medium of the portable device from an unavailable state to an available state after the accounting points are updated correctly.

A functional advantage of the above-noted features of the present invention, enabled because of the claimed structure, is that a downloaded file is made available in the portable device by carrying out point processing in the terminal device without having to transfer the downloaded file to the second memory of the terminal device. In other words:

the file down-loaded to the portable device 50 can also be made available in the portable device 50 by carrying out only the point processing at the recording/reproducing device 10, without shifting the file to the HDD 15 of the recording reproducing device 10.

(Specification 56 11.10-13.)

As explained with regard to FIG. 14, in order to do this:

the CPU 11 monitors the connection with the portable device 50. When the connection with the portable device 50 is detected, the CPU 11 advances to step S82 and confirms the file stored on the HDD 54 of the portable device 50. At step S83, the CPU 11 discriminates whether or not there is any file in the use prohibition state at that time. The case where there is a file in the use prohibition state is the case where there is a file of chargeable information which is down-loaded from the down-load device 6 by using the portable device 50 and for which the accounting processing has not been carried out yet.

Thus, at step S84, the CPU 11 confirms the number of points of the point memory 45 and discriminates whether or not the number of points equivalent to the fee for the file in the use prohibition state is left as the number of points PT. If the number of points

PT is left, the CPU 11 at step S85 subtracts the number of points PT.

Subsequently, at step S86, the CPU 11 regards that the fee has been paid for the file in the use prohibition state stored on the HDD 54 of the portable device 50, and sets the information use permission flag in the on-state, that is, the use permission state. Specifically, the CPU 11 sets the information use permission flag in the on-state by directly accessing the HDD 54 or through the CPU 51. Thus, the user can use the chargeable information down-loaded to the portable device 50.

If the number of points is insufficient at step S34, the file in the portable device 50 is still in the use prohibition state and therefore the use must carry out the point purchase.

(*Id.* 1.16 to p.57 1.15)

A. Obviousness Rejection Based On Peterson '020

It is respectfully submitted that claim 9 is not obvious in view of Peterson '020. For instance, *Peterson '020* fails to show or suggest "a detector configured to detect whether a portable device with a storage medium is connected to the terminal device," wherein when a connection is detected, attributes of information stored in the storage medium of the portable device are updated to an available state after the accounting points are updated correctly. In *Peterson '020* there is no portable device detachable from the terminal device, therefore the first controller of the terminal device cannot be used to update the attributes of the information stored in the portable device.

Specifically, claim 9 requires that "when the detector detects that the portable device is connected to the terminal device, the first controller updates attributes of information stored in the storage medium of the portable device from an unavailable state to an available state after the accounting

points are updated correctly." Peterson '020 does not disclose the claimed limitation. The Examiner has taken the position that this limitation is "merely conditional phraseology . . . having no patentable weight." (Oct. 12, 2004 Office Action 3)

Regarding the Examiner's assertions set forth on page 3 of the October 12, 2004 final rejection, which state that the limitation beginning with "when the detector..." is merely functional language having no patentable weight, it is respectfully submitted that the Court of Customs and Patent Appeals ("C.C.P.A.") has held "that there is nothing intrinsically wrong in defining something by what it does rather than by what it is." *In re Hallman*, 655 F.2d 212, 215 (C.C.P.A. 1981). Furthermore, "functional language in the claims **must be given full weight and may not be disregarded** in evaluating the patentability of the subject matter defined employing such functional language" *Ex parte Bylund*, 217 U.S.P.Q. 492 (Bd. App. 1981), emphasis added.

Furthermore, the M.P.E.P. and other case law are clear that limitations in a claim which are material to patentability cannot be ignored.

Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language that does not limit a claim to a particular structure. However, examples of claim language, although not exhaustive, that may raise a question as to the limiting effect of the language in a claim are:

- (A) "adapted to" or "adapted for" clauses;
- (B) "wherein" clauses; and
- (C) "whereby" clauses.

The determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case. In *Hoffer v. Microsoft*

Corp., 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005)

M.P.E.P. § 2111.04 (8th ed. Rev. 3 August 2005).

According to *Hoffer*, "when the 'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329 (Fed. Cir. 2005) cert. denied, 126 S.Ct. 928 (2006) (emphasis added). In the instant claim, the limitation at issue is "when the detector detects. . . ." This is not optional language, but rather defines actions that occur when a specific condition is met. Thus, it is error to ignore the claim limitation and give it no patentable weight.

In addition, the Examiner has admitted that *Peterson* '020 "does not directly disclose that when the distributed information is stored in the second memory, . . . the first controller updates the accounting points stored in the first memory based on the distributed information." (Examiner's Answer 8, ¶ 30, May 19, 2005.) Nonetheless, the Examiner states that this claimed feature "would have been obvious . . . in an effort to access the non secured data 22. This one time connection fee would have allowed the distributor to receive additional income (on a one time only basis) from the non secured data 22." (Examiner's Answer, 8-9)

In response to the above statement by the Examiner, the applicant refers to *In re Oetiker*, in which the Federal Circuit stated:

There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from the applicant's invention itself.

In re Oetiker, 977 F.2d 1443, 1447 (Fed. Cir. 1992).

The Examiner provides no explanation from the prior art or any discussion of the teachings or motivation of the prior art in support of this contention. It appears that the obviousness argument for the aforementioned claim limitation is hindsight reconstruction based on applicant's own specification, which is impermissible. In support thereof, reference is made to *In re Dembiczak*, in which the Federal Circuit stated:

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. Combining prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight.

In re Dembiczak, 175 F.3d 994, 999 (Fed. Cir. 1999).

**B. OBVIOUSNESS REJECTION BASED ON
PETERSON '020 IN VIEW OF HOW COMPUTERS WORK**

As discussed above in the "Grounds of Rejection to be Reviewed on Appeal," the second ground of rejection is whether claim 9 is patentable under 35 U.S.C. § 103(a) over *Peterson '020* in view of *How Computers Work*. This is a new ground of rejection raised in the previously filed Examiner's Answer. According to the Examiner's Answer, this alternative rejection "simply incorporates *How Computers Work* in the statement of rejection." (Examiner's Answer 4, ¶ 13.)

How Computers Work is merely relied on in the rejection to show a serial connection between a CD-ROM and a computer. (Examiner's Answer 17, ¶ 54.) The Examiner's Answer does not state that *How Computers Work* overcomes any of the deficiencies

of *Peterson '020*, for example the deficiency identified in numbered paragraph 30 of the Examiner's Answer pertaining to the fact that *Peterson '020* does not directly disclose updating of accounting points by a first controller when distributed information is stored in a second memory.

Accordingly, it is respectfully submitted that claim 9 is patentably distinct over *Peterson '020*, and is patentably distinct over the applied combination of *Peterson '020* and *How Computers Work*.

A reversal of the final rejection of claim 9 by this Honorable Board is respectfully requested.

Dated: August 2, 2006

Respectfully submitted,

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CLAIMS APPENDIX

Claim 9 (finally rejected). An accounting system including an accounting center and a terminal device communicating with the accounting center,

the terminal device comprising:

a first memory configured to store accounting points, the first memory being built-in in the terminal device;

a second memory configured to store distributed information distributed from an external source;

a first controller configured to update the accounting points stored in the first memory and to update attributes of the distributed information when the distributed information is stored in the second memory;

a second controller configured to transmit a request for purchasing the accounting points to the accounting center and to update the accounting points stored in the first memory based on an accounting processing corresponding to the accounting points executed at the accounting center; and

a detector configured to detect whether a portable device with a storage medium is connected to the terminal device, wherein

when the distributed information is stored in the second memory, the first controller updates the attributes of the distributed information to an unavailable state and updates the accounting points stored in the first memory based on the distributed information, and when the accounting points are not updated correctly, the second controller transmits the request for purchasing the accounting points to the accounting center and updates the accounting points, and the first controller updates the attributes of the distributed information from the unavailable state to an available state, and

when the detector detects that the portable device is connected to the terminal device, the first controller updates

attributes of information stored in the storage medium of the portable device from an unavailable state to an available state after the accounting points are updated correctly, and

the accounting center comprising:

a third controller configured to carry out an other accounting processing based on the request for purchasing the accounting points transmitted from the terminal device by the second controller.

EVIDENCE APPENDIX

No evidence has been submitted pursuant to 37 C.F.R. §§ 1.130, 1.131 or 1.132 which is relied upon by appellant in the appeal.

RELATED PROCEEDINGS APPENDIX

There are no decisions by the Board of Patent Appeals and Interferences in the concurrent appeals of the Parent and Sibling Applications identified in the section entitled "Related Appeals and Interferences."